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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/084,473	02/28/2002	Mitsutoshi Abe	381NP/50961	7826

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EXAMINER

JONES, JUDSON

ART UNIT	PAPER NUMBER
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2834

DATE MAILED: 06/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/084,473

Applicant(s)

ABE ET AL.

Examiner

Judson H. Jones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 24-29 is/are pending in the application.
- 4a) Of the above claim(s) 13 and 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 1-12, 14, 16, 17 and 24-29 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 021704.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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Ex Parte Quayle

This application is in condition for allowance except for the following formal matters:

Objections to the claims and amended claims drawn to non-elected subject matter.

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

Claim Objections

Claims 1-17 and 24-29 are objected to because of the following informalities: In claims 1-4 in line 3 “any of outer surface and surface exposed to a magnetic core housing” is unclear. “Any of outer surface” could refer back to “an electric equipment for mounting on vehicles” or it could refer forward to “a magnetic core housing.” Furthermore surface exposed to a magnetic core housing is unclear. This could mean an exposed surface of the magnetic core housing or it could refer to another surface adjacent to the housing. If it means the former, then outer surface and exposed surface seem to be repeating the same limitation. In the last two lines of the claim the same problem exists. “Coating at an outer peripheral surface” and “outer exposed portion” appear to be saying the same thing because the outer exposed portion will necessarily be a part of the outer peripheral surface. Also there is no clear connection between an electric equipment and the magnetic core housing. Nothing in the claim says the magnetic core housing is a part of the electric equipment. Lastly, “electric equipment” is improper grammar. The correct

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phrase is “electrical equipment.” See applicant’s specification page 2 paragraph 0007 where “electrical equipment” is used correctly. Appropriate correction is required.

The machine translation of applicant’s Japanese priority document claim 1 reads, “Mounted electronic autoparts characterized by performing a metal plating layer, a chromate film, and organic paint to the front face exposed to the periphery front face of a magnetic-core case, or its exterior one by one.” In this claim, the periphery front face of the magnetic core appears to be included in its exterior and therefore the word “or” is being used improperly.

The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

Newly amended claims 13 and 15 are directed to an invention that is independent or distinct from the elected invention for the following reasons: These are method of making claims drawn to a manufacturing method, classified in class 29, subclass 596. Applicant’s manufacturing method claims were non-elected by applicant in the response of 11/7/2003. Accordingly, claims 13 and 15 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Allowable Subject Matter

Claims 1-12, 14, 16, 17 and 24-29 are allowed, provided the objections to the claims are overcome.

The following is a statement of reasons for the indication of allowable subject matter: The prior art of record does not disclose or teach an outer surface of an electrical equipment for mounting on a vehicle with an outer peripheral surface coated with a metal plated layer, a chromate film and organic resin coating as recited in claims 1-4. The prior art of record discloses stock material having a metal plated layer, a chromate film and organic resin coating but it would not be possible to make an electrical equipment housing out of such stock material without having some of the outer periphery of the housing being uncoated unless additional manufacturing steps were taken. The only ways to meet the claim language would be to cut stock material, coat it and then assemble it into a housing or to cut stock material, assemble it into a housing and coat it. While the prior art does suggest the desirability of doing this, the motivation here seems to be obvious to try instead of obvious to do.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Prohaska 5,201,111 A discloses coating the housing of a motor with a powder and applying heat to the powder. Lee 1,967,031 A teaches coating small metal articles in a vat.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judson H. Jones whose telephone number is 571-272-2025. The examiner can normally be reached on 8-4:30 M-F.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Darren Schuberg can be reached on 571-272-2044. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JHJ 6/4/2004



THANH LAM
PRIMARY EXAMINER